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REMARKS

INTRODUCTION

In accordance with the foregoing, claims 3, 4, and 8 have been amended, and claims 1-2, 5-7, and 9-16 have been canceled, without prejudice or disclaimer. No new matter has been submitted.

Claims 3, 4 and 8 are pending and under consideration.

REJECTION UNDER 35 USC 112

Claim 9 stood rejected under 35 USC § 112, second paragraph, for typographical errors.

As correctly pointed out in the Office Action claim 9 included antecedent informalities, which have accordingly been corrected in the above amendments of the same features included in independent claim 8.

Accordingly, entry of the above amendments and withdrawal of the outstanding rejection is respectfully requested.

REJECTION UNDER 35 USC 103

Claims 3, 4, and 8 stand rejected under 35 USC §103 as being obvious over Burke, U.S. Patent No. 6,032,162, in view of Harding, U.S. Patent No. 6,307,544. Features from canceled claims 5 and 9, which stood rejected under 35 USC § 103 as being obvious over Burke and Harding, in view of Hoyle, U.S. Patent No. 6,628,314, have been in incorporated into claims 3-4 and 8, respectively. The outstanding rejections are respectfully traversed.

First, regarding the above amendments to claims 3 and 4, it is respectfully submitted that it would not have been obvious to modify Burke, Harding, or Hoyle, alone or in combination, to disclose the claimed "wherein the server stores a plurality of advertisements and transmits at least one advertisement to the client PC, for display as the advertisement, at a request of the client PC or at predetermined time intervals, and wherein the advertisement is not displayed, but the at least one of the menu bar, tool bar, location bar, and/or browser logo are displayed when the cursor is located in the area of the display screen where the at least one of the menu bar, tool bar, location bar, and/or browser logo are to be displayed," as incorporated into claims 3 and 4.

Similarly, it is respectfully submitted that it is respectfully submitted that it would not have been obvious to modify Burke, Harding, or Hoyle, alone or in combination, to disclose the

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claimed "receiving an advertisement update from the server at a request of the client PC or at predetermined time intervals," as incorporated into claim 9.

Secondly, in the previous response, applicant particularly discussed what each cited reference actually discloses, and discussed the inadequacies of the proffered obviousness rejection. Thus, the following is again respectfully submitted, and applicants again respectfully submit that it wouldn't have been obvious to make the proffered combination suggested in the Office Action. In addition, as noted above, it is further submitted that it would not have been obvious to modify the cited references to disclose the currently amended claims 3, 4 and 9.

As noted previously, the Office Action relies on Burke appears to disclose a web browser directed to remote bookmark access, with areas of the browser display including browser control information/buttons, outside of a text area including downloaded html data, and advertisements. Burke does not disclose any selective display switching between control information/button display and advertisement based on a cursor placement.

To disclose this selective element, the Office Action relies on Harding, which discloses a help system that permits the display of more detailed additional information/options for a user when a user hovers a cursor over a corresponding area. The more detailed additional information/options include more detailed information or options for the initial item where the cursor is hovered over. This would appear similar to word processing programs that display more menu items, of a menu list, when a cursor is hovered over an area of the menu list, so the menu list can be simplified.

In Harding, the purpose of permitting the additional information/options for the user is not really to simplify the display of an item, but rather to permit a user to view more information related to an area/item. Harding provides an example of hovering over a button and having a menu list appear near that button providing more information about that button and additional operations related to that button.

To disclose the aforementioned selective switching between displaying of the menu bar, tool bar, location bar, and/or browser logo or an advertisement, upon the movement of a cursor to the menu bar, tool bar, location bar, and/or browser logo area, the Office Action sets forth that it would have been obvious to incorporate the hovering/menu feature of Harding into Burke.

Particularly, the Office Action states: "[w]hile Burke teaches adds and menus in these screen regions, Burke does not teach dynamic display of them based upon a user's mousing properties. Harding teaches a GUI for a software application whereby when a user's mouse

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hovers over a particular area of the interface, clickable, cascading menus appear in order to launch other applications or applets."

The rational for the combination is stated to be that "[i]t would have been obvious to one of ordinary skill at the time of the invention to have provided the advertising of Burke in the suggested screen areas and dynamically changed such screen regions to popup menus for further browser functionality when a user hovers the mouse in the area in order to provide an easy to [use] graphical interface."

Thus, the underlying reason for modifying Burke to include the dynamic hovering/menu features of Harding is "to provide an easy to [use] graphical interface."

However, it is respectfully submitted that without first reading the present application, one skilled in the art would not have had any reason/desire to make the proffered modification of Burke.

As noted above, Burke appears to be directed toward improved bookmarks access using a remote server. As a side note, Burke illustrates a typical browser display and indicates that two areas could include advertisement and typical browser control information/buttons. Thus, in passing, Burke discusses display of advertisement and typical browser control information/buttons, while the primary focus of the Burke disclosure is directed toward the improved server accessible bookmarks.

On the other hand, Harding would appear to be unrelated to either server access of bookmarks or to advertisement displaying. The focus in Harding is on providing "clickable, cascading menus," upon a cursor hovering over a particular item/button. The only correlation between Burke and Harding would appear to be that both would have cursors and operate within a computer application. At most, it could only be argued that the disclosure of Harding may lead one to incorporate the invention thereof in the browser of Burke, i.e., add the cascading menus option to Burke when a cursor hovers over and item/button.

The Office Action indicates that it would have been obvious to make the modification of Burke to dynamically switch advertisements with the claimed tool bar, menu bar, navigation bar, and/or browser logo, since the underlying principle of Harding is the dynamic aspect of performing some operation based on a hovering of the cursor.

However, it is respectfully submitted that it is a huge leap from Harding disclosing cascading menus based on a hovering of the cursor to completely changing the display operation of Burke to dynamically switch between an advertisement and the claimed tool bar,

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menu bar, navigation bar, and/or browser logo.

Essentially the Office Action is taking a dynamic menu display operation and picking and choosing how to incorporate it into Burke to disclose the presently claimed invention, when there would not appear to be any reason for the same without reliance on the disclosure of the present application. Again, there is no disclosure or suggestion in Harding to dynamically switch between displaying an advertisement and a tool bar, menu bar, navigation bar, and/or browser logo.

Thus, it is respectfully submitted that it would not have been obvious to modify Burke, as proffered. It is further submitted that neither Harding nor Burke disclose or suggest the proffered combination. Even if the two inventions are combined, they still would not disclose the presently claimed invention.

In addition, it is respectfully submitted that it would not have been obvious to modify Burke, Harding, or Hoyle, to disclose *"wherein the server stores a plurality of advertisements and transmits at least one advertisement to the client PC, for display as the advertisement, at a request of the client PC or at predetermined time intervals, and wherein the advertisement is not displayed, but the at least one of the menu bar, tool bar, location bar, and/or browser logo are displayed when the cursor is located in the area of the display screen where the at least one of the menu bar, tool bar, location bar, and/or browser logo are to be displayed,"* as incorporated into claims 3 and 4. Similarly, it is respectfully submitted that it is respectfully submitted that it would not have been obvious to modify Burke, Harding, or Hoyle, alone or in combination, to disclose the claimed *"receiving an advertisement update from the server at a request of the client PC or at predetermined time intervals,"* as incorporated into claim 9.

Again, as noted previously, it is noted that the primary motivation for making the aforementioned combination is presently "to provide an easy to [use] graphical interface." It would appear that this motivation is merely the opinion of the Examiner, and lacking support in the cited references. It is respectfully requested that any further Office Actions particularly provide concrete support for the recited motivation and detailed correspondence between the same and the proffered combination features.

Therefore, for at least the above, it is respectfully submitted that a prima facie obviousness case has not been set forth. The proffered motivation lacks concrete support from the record, the proffered combination would not have been combinable as suggested, and there would not have been any reason to modify Burke to take the dynamic aspect of Harding without basing the same on the disclosure of the present application.

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Lastly, in response to applicants previous traversals, the outstanding Office Action has presented no rebuttal or countering analysis. Rather, it is respectfully submitted that the Office Action has set forth only a conclusory statement that the proffered combination would have been obvious because the addition of features of Harding to Burke would permit to Burke have the features, which is merely circular and conclusory.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)

Similarly, "[t]he factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires concrete evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings. The relied upon motivation must be evidenced in the record and cannot be based on a subjective belief of unknown authority.

It is respectfully submitted that the outstanding §103 rejections fail to set forth a prima facie obviousness case. The underlying rationale for each combination is derived from the

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Examiner's own beliefs and not from objective evidence in the record.

Further, again, it is respectfully submitted that it would not have been obvious to modify the cited references to disclose claims 3, 4, and 8, as amended.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.
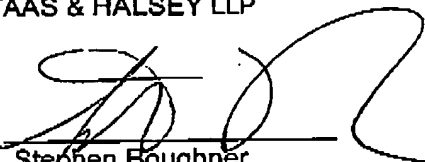
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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